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REMARKS

Claims 14-38 are currently pending in the subject application and are presently under consideration. Claims 35-38 have been amended herein to correct minor informalities. Independent claims 14 and 21 have been amended herein to explicitly recite what was already inherently in the claims. Applicants' representative notes that the amendments do not necessitate a new search or any undue effort by the Examiner because they do not present new claimed subject matter. Accordingly, entry and consideration of these amendments is respectfully requested. A version of all claims is listed at pages 2-5 of this Reply.

Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I. Rejection of Claims 21-24, 28, 29, and 32 Under 35 U.S.C. § 103(a)

Claims 21-24, 28, 29, and 32 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Petteruti, *et al.* (U.S. 5,335,170) in view of VanHorn, *et al.* (U.S. 5,736,726). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Petteruti, *et al.* and VanHorn, *et al.*, alone or in combination, fail to teach or suggest all the features of the subject claims. In addition, the Examiner has not provided proper motivation to combine the teachings of Petteruti, *et al.* and VanHorn, *et al.*

To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) **must teach or suggest all the claim limitations**. See MPEP §706.02(j). The *teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art and not based on the Applicant's disclosure*. See *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). An examiner cannot establish obviousness by locating references which describe various aspects of a patent applicant's invention **without also providing evidence of the motivating force which would impel one**

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skilled in the art to do what the patent applicant has done.
Ex parte Levengod, 28 USPQ2d 1300 (P.T.O.B.A.&I.
1993).

The subject invention relates generally to hand-held devices for acquiring data and particularly to an optical scanning device, providing a pistol configuration with an improved ergonomic arrangement, which can be more stable for users as compared to conventional hand held devices. In particular, as recited in amended independent claim 21, the subject invention provides for a hand-held optical scanning device, having a body having an optical scanning module arranged to scan objects in a direction outward from a first distal end, the body including an upper surface having a display mounted thereof, and a handle that extends from a bottom surface of the body at the first distal end to increase a viewing angle of the display, the handle being *non-detachably* joined to the body to support a proximal end of the bottom surface of the body by resting the handle on *a radial surface of a user's hand to provide support*. Neither Petteruti, *et al.* nor VanHorn, *et al.*, alone or when combined, teach or suggest these novel features.

The Final Office Action dated July 27, 2005, concedes that Petteruti, *et al.* does not teach or suggest all the aspects of the subject claims, but incorrectly contends that VanHorn, *et al.* will cure the deficiencies of Petteruti, *et al.* Rather, VanHorn, *et al.*, discloses that the handle is detachable. (See col. 3, ln. 15-19; Figures 1 and 2). Accordingly, VanHorn, *et al.* fails to teach or suggest the handle being *non-detachably* joined to the body, as recited in independent claim 21.

Moreover, contrary to the Examiner's assertions, VanHorn, *et al.* does not teach or suggest the handle being non-detachably joined to the body to support a proximal end of the bottom surface of the body by resting the handle on *a radial surface of a user's hand to provide support*. Rather, the reference illustrates a pistol configuration (See Abstract) that can be grasped or gripped by the operator's hand (See col. 5, ll. 17-19), but is silent with respect to the body resting on the hand to provide support. In particular, the pistol configuration of the reference shows an angle of approximately 13.4 degrees with respect to a line perpendicular to the base of the body. An angle of 13.4 degrees is insufficient to rotate or extend the radial surface of a user's hand in order to come into contact with the base while the handle is gripped. In contrast, the subject invention, as depicted in Fig. 1, has an angle of approximately 36.3 degrees with respect to perpendicular to the body. This angle of the handle in the subject invention can allow the *resting* of the handle on *a radial surface of a user's hand to provide support*. In

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VanHorn, *et al.*, given the much smaller angle of the handle, the handle is not touching, let alone rested on the user's hand.

Furthermore, assuming *arguendo* that the body of the reference does touch a radial surface of a user's hand, it is readily apparent that it is *not resting* on a radial surface of a user's hand *to provide support*. Rather, in VanHorn, *et al.* it can be seen from Fig. 3 that if the scanner rotates clockwise about the handle, the hand strap hinge 117 will contact the user's wrist in the resting condition, not the radial surface of the user's hand because the proximal end of the scanning device extends out well past the radial surface of the user's hand and the hand strap hinge 117 is the lowest point on the bottom of the scanner. Additionally, if the scanner in VanHorn, *et al.* is balanced so that the scanner rotates counterclockwise, that will result in the handle not resting on the radial surface of the user's hand. Furthermore, at page 4 of the Final Office Action, the Examiner suggests that the invention was made to incorporate a handle configuration in order to provide a pistol-like configuration of hand-held optical scanner, such that an operator may grip the pistol gripping portion of the handle like the hand of a pistol, which minimizes the fatigue associated with operating the hand-held optical scanner for an extended period of time. VanHorn, *et al.* actually suggests the option of selecting between two different gripping configurations, **with and without the handle** to avoid repetitive motions over a long period of time. (*See* col. 3, ln. 15-19).

With regard to the Examiner's Official Notice contentions, the Office Action relies on improper hindsight in reaching an obviousness determination. The Federal Court has held that to imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher. One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to depreciate the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d (BNA) 1596 (Fed. Cir. 1988) (citations omitted).

For at least the foregoing reasons, it is readily apparent the Petteruti, *et al.* individually or in combination with VanHorn, *et al.* fails to teach or suggest all the claimed aspects of the subject invention. Accordingly, independent claim 21 (and claims

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22-24, 28-29 and 32 depending therefrom) is believed to be in condition for allowance. Withdrawal of this rejection is respectfully requested.

II. Rejection of Claims 14-17, 20, and 33 Under 35 U.S.C. § 103(a)

Claims 14-17, 20, and 33 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Petteruti, *et al.* as modified by VanHorn, *et al.*, as applied to claim 21 and further in view of Wakatsuki, *et al.* (U.S. 5,023,438). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Petteruti, *et al.*, VanHorn, *et al.* and Wakatsuki, *et al.* alone or in combination, fail to teach or suggest all the features of the subject claims.

Withdrawal of this rejection is respectfully requested for at least the following reasons. Independent claim 14 has been amended herein to emphasize various aspects of the claimed invention. As amended, independent claim 14 (and similarly independent claim 21) recites a handle being non-detachably joined to the body to cause the handle to rest on the surface of a user's hand to facilitate stability and weight distribution. Wakatsuki, *et al.* does not make up for the aforementioned deficiencies of Petteruti, *et al.*, alone or in combination with VanHorn, *et al.* as set forth *supra*. Accordingly, this rejection should be withdrawn.

III. Rejection of Claims 34 and 38 Under 35 U.S.C. § 103(a)

Claims 34 and 38 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Petteruti, *et al.* as modified by VanHorn, *et al.*, as applied to claim 21 and further in view of Williamson, *et al.* (US 5,475,381).

Withdrawal of this rejection is respectfully requested for at least the following reasons. Claims 34 and 38 depend from independent claim 21. Williamson, *et al.* does not make up for the aforementioned deficiencies of VanHorn, *et al.* with respect to the independent claim 21. Thus, the subject invention as recited in independent claim 21 (and claims 34 and 38 depending therefrom) is not obvious over Petteruti, *et al.* as modified by VanHorn, *et al.* in view of Williamson, *et al.* Accordingly, this rejection should be withdrawn.

IV. Rejection of Claim 36 Under 35 U.S.C. § 103(a)

Claim 36 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Petteruti *et al.* as modified by VanHorn, *et al.* and Wakatsuki, *et al.* as applied to claim 14 above, and further in view of Williamson, *et al.*

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Withdrawal of this rejection is respectfully requested for at least the following reasons. Claim 36 depends from independent claim 14. Wakatsuki, *et al.* does not make up for the aforementioned deficiencies of VanHorn *et al.* with respect to the independent claim 14. Thus, the subject invention as recited in independent claim 14 (and claims 34 and 38 depending therefrom) is not obvious over Petteruti, *et al.* as modified by VanHorn, *et al.* in view of

Williamson, *et al.* and Wakatsuki, *et al.* Accordingly, this rejection should be withdrawn.

V. Rejection of Claims 18 and 19 Under 35 U.S.C. § 103(a)

Claims 18 and 19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Petteruti, *et al.* as modified by VanHorn, *et al.* and Wakatsuki, *et al.* as applied to claim 14 above, and further in view of Reynolds, *et al.* (U.S. 5,828,052).

Withdrawal of this rejection is respectfully requested for at least the following reasons. Claim 18 and 19 depend from independent claim 14. Reynolds, *et al.* does not make up for the aforementioned deficiencies of VanHorn *et al.* with respect to the independent claim 14. Thus, the subject invention as recited in independent claim 14 (and claims 18 and 19 depending therefrom) is not obvious over Petteruti, *et al.* as modified by VanHorn, *et al.* and Wakatsuki, *et al.* and further in view of Reynolds, *et al.* Accordingly, this rejection should be withdrawn.

VI. Rejection of Claims 25-27 and 30 and 31 Under 35 U.S.C. § 103(a)

Claims 25-27 and 30 and 31 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Petteruti, *et al.* as modified by VanHorn, *et al.*, as applied to claim 21 above, and further in view of Reynolds, *et al.*

Withdrawal of this rejection is respectfully requested for at least the following reasons. Claims 25-27 and 30-31 depend from independent claim 21. Reynolds, *et al.* does not make up for the aforementioned deficiencies of VanHorn *et al.* with respect to the independent claim 21. Thus, the subject invention as recited in independent claim 21 (and claims 25-27 and 30-31 depending therefrom) is not obvious over Petteruti, *et al.* as modified by VanHorn, *et al.* and further in view of Reynolds, *et al.* Accordingly, this rejection should be withdrawn.

VII. Rejection of Claim 37 Under 35 U.S.C. § 103(a)

Claim 37 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Petteruti, *et al.* as modified by VanHorn, *et al.*, as applied to claim 21 above, and further in view of Harden, *et al.* (U.S. 5,237,162).

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Withdrawal of this rejection is respectfully requested for at least the following reasons. Claim 37 depends from independent claim 21. Harden, *et al.* does not make up for the aforementioned deficiencies of VanHorn *et al.* with respect to the independent claim 21. Thus, the subject invention as recited in independent claim 21 (and claim 37 depending therefrom) is not obvious over Petteruti, *et al.* as modified by VanHorn, *et al.* and further in view of Harden, *et al.* Accordingly, this rejection should be withdrawn.

VIII. Rejection of Claim 35 Under 35 U.S.C. § 103(a)

Claim 35 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Petteruti, *et al.* as modified by VanHorn, *et al.*, Wakatsuki *et al.* as applied to claim 14, and further in view of Harden, *et al.*

Withdrawal of this rejection is respectfully requested for at least the following reasons. Claim 35 depends from independent claim 14. Harden, *et al.* does not make up for the aforementioned deficiencies of VanHorn *et al.* with respect to the independent claim 21. Thus, the subject invention as recited in independent claim 21 (and claim 35 depending therefrom) is not obvious over Petteruti, *et al.* as modified by VanHorn, *et al.* and further in view of Hayden, *et al.* Accordingly, this rejection should be withdrawn.